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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,480	07/21/2003	Jean-Christophe Simon	032487-005	4520

7590 03/20/2007  
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EXAMINER
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YU, GINA C

ART UNIT	PAPER NUMBER
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1617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/622,480	<b>Applicant(s)</b> SIMON ET AL.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6-9 and 15-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-9 and 15-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on December 28, 2006. Claims 1, 6-9, 15-48 are pending. Claim rejections as indicated in the previous Office action dated June 28, 2006 are withdrawn in view of the claim amendments made by applicants. Claims 1, 6-9, 15-48 are pending. New rejections are made as shown below.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1, 6-9, 15-28, 30-41, 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon (FR 2777178) in view of applicants' own disclosure and Ramin (EP 1082952 A1).**

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Simon teaches cosmetic compositions comprising goniochromatic coloring agents and monochromic pigments such as titanium dioxide. See English equivalent, US 6451294 B1, col. 5, lines 41 – 65. See instant claims 1, 40, 41. The liquid crystal colorants and multilayer structured colorants, such as Al/SiO<sub>2</sub>/Al/SiO<sub>2</sub>/Al and Fe<sub>2</sub>O<sub>3</sub>/SiO<sub>3</sub>/Al/SiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub>, are taught. See col. 3, line 49 – col. 5, line 13. See instant claims 30-32. Mica covered with titanium oxide meets limitation “particles of a substrate at least partially coated with at least one layer of at least one metal”. See col. 4, line 4: instant claims 5-11. The reference also teaches the amount of which goniochromatic or monochromic pigment is used. See col. 5, lines 34-40. See instant claims 26-28, 33, 34, 35.

Simon also teaches making lip gloss paste, lipstick, nail varnish, foundation, and mascara by applying the teaching of the reference. See col. 8, lines 49 – 67; instant claims 44 – 48.

The prior art meets every limitation of instant claim 1. Since the composition and its properties are inseparable, the prior art composition having at least one goniochromatic compound and at least one light reflecting pigment as defined in claim 1 inherently has the “mean gloss” properties as defined in the instant claims 15–17.

The reference teaches using the hydrocarbon oils, paraffins, Parleam, silicone oils, etc. See col. 6, line 55 – col. 7, line 37. The limitation of instant claims 36-39 are met since applicants’ disclosure provides that these oils are useful to be liquid gloss and reflective index of between 1.47-1.51. See specification, p. [00113]-[00121].

Simon fails to teach the metal-coated glass particles of instant claim 1.

Ramin teaches glass particles coated with at least one metallic compound. The reference teaches using these particles in the most preferred amount of 2-10 % by weight. See col. 2, lines 38 – 42; Examples; instant claims 1 (b), 26-28. The reference teaches that the compositions can “afford a make-up film which has a very shiny, sparkling metallic appearance, with a mirror effect, irrespective of the direction of observation, and which does not scatter light. The make-up can also have good wear resistance, resistance to impacts, rubbing and abrasion, as well as good resistance to chipping. Furthermore, the glass particles can transmit light well, which allows the glass particles to be combined with at least one colored pigment in order to obtain colored make-up with a metallic effect”. See col. 1, lines 50 – 65.

The reference teaches that the composition can also comprise at least one additional dyestuff other than the glass particles, including nacles and flakes that are well known in the art. See col. 6, lines 6 –18; instant claims 40 and 41. The average size of the coated glass particles ranges from 1-25 microns; and the thickness ranges from 0.1-25 microns. See instant claims 21-25. With respect to claims 15-20, it is viewed that

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Simon by substituting the reflective particles with the metal-coated glass particles of Ramin, as motivated by the latter, because 1) both references are directed to cosmetic composition which utilizes reflective pigments; and 2) Ramin teaches specific cosmetic benefits of the metal-coated glass particles, which include, shiny, metallic appearance with a mirror effect from all angles and resistance to wear, impact, rubbing, and abrasion. Since both of the

references teaches making nail varnish compositions, and Ramin teaches that the glass particles can be concurrently used with other pigments, the skilled artisan would have had a reasonable expectation of successfully producing a stable nail varnish composition with enhanced cosmetic metallic effect.

**Claims 1, 6-11, 15-20, 26-29, 33-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 6759052 B1) in view of applicants' own disclosure and Blin et al. (FR 2816830).**

Suzuki teaches using 4 % of titanium-dioxide coated glass flake in a lipgloss composition comprising a lipophilic carrier, which is a mixture of polybutene and silicon oil. See instant claims 1, 26-29, 43, 44-46. The reference fails to teach another light-reflecting pigment (goniochromatic pigment of instant claim). The terms 'foundation' and 'mascara' refer to the intended use of the composition, thus no patentable weights are given to these terms. See instant claims 47 and 48.

Suzuki uses the hydrocarbon oils, paraffins, silicone oils, etc. The limitation of instant claims 36-39 are met since applicants' disclosure provides that these oils are useful to be liquid gloss and reflective index of between 1.47-1.51. See applicants' specification, p. [00113]-[00121].

Blin et al. teach using flat fibers in cosmetic composition with continuous lipophilic phase. See English equivalents, US 2004/0076649 A1, [0008-0012]. See instant claim 33-35, 42, 43, and 46. The reference teaches that the cosmetic compositions include lip products which are colored, or a top coat products to modify keratinous materials which already have make up compositions applied. The reference teaches that the incorporation of flat fibers into the composition can be done very easily,

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without losing the cosmetic properties of the composition, while forming a deposit exhibiting a velvety feel to the touch due to the homogeneous dispersion of the flat fibers in the composition. The deposit of the composition provides good feel and mechanical resistance, a bright visual effect when formulated in a translucent carrier. The suitable oil carrier includes cyclic silicone oils and hydrocarbon oils such as paraffin oils. See [0066]. The reference also teaches adding to the top composition preferably 0.02-20 % by weight of additional pigments selected from pearlescent agents, such as mica coated with titanium oxide or iron oxide. See [00127]. See instant claims 1, 5-11, 15-20, 40, 41. The flat fibers have length of 1-10 microns. See [0027]; See instant claim 26-28.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Suzuki by incorporating the flat fibers of Blin, as motivated by the latter reference, because both references teaches the application of the respective inventions in lip products and those products are applied over a already made-up skin or lips, and the lipgloss of the Suzuki reference is oil-based; and Blin teaches the advantages of incorporating the flat fibers in oil-based cosmetic compositions, which include bright visual effect, good feel and mechanical resistance.. The skilled artisan would have had a reasonable expectation of successfully producing a stable lip gloss composition comprising flat fibers with enhanced shine and feel.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 6-11, 15-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 66-73, 111-124, 143, 144 of copending Application No. 10/432329.**

The '329 claims are directed to compositions comprising interference pigment and one additional pigments such as pearlescent such as mica coated with metal oxides. See '329, claim 121; instant claims 5-11. The interference pigments of the '329 application are polymeric fibers, which are also claimed in the instant application, claim 42. The interferential particles of the copending applications, claims 112 is also claimed in instant claim 31 and 32. See also overlapping weight amount of the pigments in '329, claims 113-115 and instant claims 33-35.

While the '329 invention does not claim the reflective particle of the instant claims, Suzuki teaches that using titanium dioxide coated glass flake to make a lipgloss is well known in the art. See Suzuki, Example 11.



It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the claimed invention of '329 by incorporating titanium dioxide coated glass flake to make a lip gloss composition because both '329 and Suzuki inventions are directed to lip products and Suzuki teaches a specific formulation of such product. The skilled artisan would have had a reasonable expectation of successfully producing a stable lip gloss composition with goniochromic color effects.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 6-11, 15-20, 26-29, 33-35, 40-42, 46 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

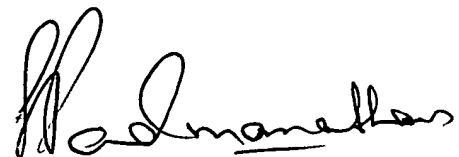
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu  
Patent Examiner



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER